

REMARKS

Claims 1-2, 4-20, and 22-65 are rejected and remain pending. Applicants thank Examiner for considering the arguments made in the previous Office Action Response. In response, Applicants respectfully traverse the Examiner's rejections. However, Applicants have taken this opportunity to offer amendments to claims 17, 19, 22-27, 29, 32-33, 50, 52, 55-58, 60, 62, and 64-65 to eliminate typographical errors and make the claim language clearer. No new matter nor new subject are introduced. Accordingly, no new searches are required, therefore, Applicants respectfully request entry of the amendments.

Claim Rejections – 35 U.S.C. § 112

On page 2 of the above-captioned Office Action, claims 1, 5, 19, 23, 35, 40, 50, 54, 64, and 65 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. On page 3, the same claims are rejected under § 112, first paragraph, as failing to comply with the enablement requirement. In particular, Examiner states that he was unable to find support for the limitations “amplifying information of the first information page” and “abstracting a plurality of locators of a plurality of locations having information that amplifies the information of the first information page” as recited in the rejected claims. To comply with the written description requirement, claim limitations need not be described literally, but the specification must reasonably convey to one of ordinary skill that Applicants were in possession of the claimed subject matter as of the filing date. (See MPEP 2163.02.) Additionally, to comply with the enablement requirement, the written description must provide sufficient information so that any person skilled in the art can make and use the invention without undue experimentation. (See MPEP 2164.01.)

Support for “amplifying information of the first information page” can be found at least in for example paragraph [0033] (referring to the publication of the application, US Pat. Publication No. 2002/0059223 A1). This text describes that information browsing assistance may, in embodiments, take the form of an assistance information page. XML triggers are also described, showing an example of how such information pages could be invoked. Additionally, paragraph [0039] describes that “assistance may take the form of one or more replacement information pages and/or one or more additional complementary information

pages.” One of ordinary skill in the art would recognize that an assistance information page, as well as a complementary information page, provides information that can be said to “amplify” the information of the first information page. Applicants therefore submit that the original disclosure of the above-captioned application would reasonably convey to one of ordinary skill that Applicants were in possession of the claimed subject matter, including “amplifying information of the first information page” as recited in claims 1, 5, 19, 23, 35, 40, 50, 54, 64, and 65. Also, Applicants submit that the description of paragraph [0033] would enable one of ordinary skill in the art to make and use the claimed invention. In particular, one of ordinary skill would possess the requisite skill and knowledge required to provide an amplifying page using any of various means, including using the XML triggers described in paragraph [0033], without undue experimentation.

Support for a locator based condition “abstracting a plurality of locators of a plurality of locations having information that amplifies the information of the first information page” can be found throughout the specification. For example, Figure 3b depicts a list of “URL patterns” 320 including a series of text strings and asterisks described in the specification as “wildcards”. The use of wildcards in this example means that each of these patterns potentially matches a plurality of locators, and not just a single locator. However, one of ordinary skill would recognize that these websites may not be known until a successful match and that there may be no possible matches, or only one possible match. Thus, such a locator based condition matches a plurality of locators only in the abstract, and the locator based condition can therefore be said to be “abstracting a plurality of locators of a plurality of locations” as required by the claims. Accordingly, one of ordinary skill would recognize that Applicants were in possession of such a locator based condition at the time of filing.

Additionally, the locator based conditions depicted in Figure 3b match both the locator of the first information page as well as the abstracted plurality of locators of the plurality of locations. Thus the information contained within each of the plurality of locations can be said to be relevant to the first information page. As a result, each of the abstracted plurality of locations contains information that can be said to amplify the information of the first information page. Thus, one of ordinary skill would recognize that applicants were in possession of locator based conditions “abstracting a plurality of locators

of a plurality of locations having information that amplifies the information of the first information page” as required by the claims. Additionally, one of ordinary skill would possess the requisite skill and knowledge to implement such a locator based condition, in particular by implementing the URL patterns of figure 3b, without undue experimentation.

For at least these reasons, Applicants submit that the written specification supports the inventions of claims 1, 5, 19, 23, 35, 40, 50, 54, 64, and 65 and that those claims comply with both the § 112 first paragraph written description and enablement requirements.

Claim Rejections – 35 U.S.C. § 103

On page 4 of the above captioned Office Action, Examiner rejects claims 1, 2, 4, 9-12, 16-20, 22, 25-27, 31-39, 42-44, 48-53, 56-58, and 62-64 under 35 U.S.C. §103(a) as being unpatentable over US Patent Publication No. 2001/0054064 issued to Kannan (“Kannan”) in view of US Patent No. 6,300,947 filed by Kanevsky (“Kanevsky”).

Claim 1, as amended, claims a method comprising:

determining based at least in part on content of a locator of a first information page requested to be retrieved and displayed on a client system, whether to provide information browsing assistance for the first information page, amplifying information of the first information page, said content of the locator identifying the first information page and a location from which the first information page is to be retrieved, said determining comprising analyzing the content of the locator of the first information page to determine whether the locator satisfies a locator based condition abstracting a plurality of locators of a plurality of locations having information that amplifies the information of the first information page; and

conditionally providing said information browsing assistance based at least in part on said determination.

Therefore the method of claim 1, taken as a whole as required by law, recites a locator based condition that abstracts a plurality of locators of locations where the locations corresponding to the locators thus abstracted have information amplifying the information of the first information page.

On page 5 of the above captioned Office Action, Examiner argues that Kannan discloses a locator based condition abstracting a plurality of locators having information and that the display screen customization of Kanevsky teaches “amplifying” information of a first

information page. Examiner goes on to argue that it would have been obvious to modify the teachings of Kannan, in light of the teachings of Kanevsky, to disclose (a) amplifying information of a first information page, and (b) said determining comprising analyzing the content of the locator of the first information page to determine whether the locator satisfies a locator based condition abstracting a plurality of locators of a plurality of locations having information that amplifies the information of the first information page. Examiner argues that the suggestion to modify Kannan derives from Kanevsky and that doing so would have advantageously provided a customized information page based on the display device of the user as taught by Kanevsky. Thus, Applicants understand Examiner's position to be that even though the combination of Kannan and Kanevsky fails to explicitly teach all elements of claim 1, Kanevsky nonetheless provides a suggestion to modify Kannan to achieve the method of claim 1.¹

Kannan discloses a system to determine if a website user is confused and, if so, to provide customer assistance in the form of a pop-up window. Kanevsky discloses a method for customizing a display of a web page depending on the area of a display device. For example, if the display area is larger than the web page, it is displayed in its entirety along with a display of linked web pages to give the user more information in a single display. It is this customization that Examiner points to for the proposition that Kanevsky discloses "amplifying" a first information page.

Firstly, Applicants submit that Kannan does not, as Examiner asserts, disclose "a locator based condition abstracting a plurality of locators of a plurality of locations having information" as required by claim 1. Applicants refer to page 19-20 of the Office Action response dated May 4, 2007 for arguments as to why Kannan does not teach or suggest this limitation of claim 1.

Secondly, Applicants submit that, even assuming *arguendo* that Kannan does disclose a locator based condition abstracting a plurality of locators, Kanevsky provides no suggestion to modify the locator based condition of Kannan to achieve the locator based condition of

¹ Applicants' position is that neither Kannan nor Kanevsky discloses "a locator based condition abstracting a plurality of locators of a plurality of locations having information amplifying the first information page."

claim 1. As discussed above, Examiner asserts that the motivation for so modifying Kannan would be to provide a customized display as taught by Kanevsky.

Even assuming, *arguendo*, that such provides a proper suggestion to modify Kannan to include providing “information browsing assistance ... amplifying information of a first web page”, Applicants submit that this rationale does not extend to modifying Kannan to include “a locator based condition abstracting a plurality of locators of a plurality of locations having information that amplifies the information of the first information page” as required by claim 1. As Applicants understand Examiner’s position, the “amplifying” of Kanevsky is the web page display size customization discussed in column 7, lines 10-33. However, the web page display size has nothing to do with the locator of the web page whose display is to be customized. Therefore, conditioning the customization of the display on the locator based condition of claim 1 would result in arbitrary application of the customization features of Kanevsky. Screens that are a correct size for a display screen would sometimes be “amplified” while screens that are an incorrect size would occasionally go un-amplified. Therefore, not only would such a modification of Kannan be unhelpful to achieve the display customization purpose of Kanevsky, but in fact Kanevsky teaches away from such a modification. Thus, for at least these reasons, Applicants submit that there would have been no suggestion to modify Kannan, based on the teachings of Kanevsky or otherwise, to achieve the locator based condition of claim 1.

Accordingly, Applicants respectfully submit that the combination of Kannan and Kanevsky fails to teach or suggest each and every element of claim 1 and that claim 1 is, consequently, nonobvious and therefore patentable over the combination of Kannan and Kanevsky.

Further, claims 2, 4, 9-12, 16-18 depend from claim 1 incorporating its limitations. Thus, for at least the same reasons above, Applicants submit that claims 2, 4, 10-12, and 16-18 are patentable over Kannan.

Independent claims 19, 35, 50, and 64 contain in substance the same limitations as claim 1. Additionally, claims 20, 22, 25-27, and 31-34; 36-39, 42-44, and 48-49; and 51-53, 56-58, 62-63 depend from claims 19, 35, and 50, respectively, incorporating their limitations.

Thus, for at least the same reasons as with claim 1 above, Applicants submit that these claims are also patentable over Kannan.

On page 14 of the above-captioned office action, claims 5-8, 23, 24, 40, 41, 54, and 55 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kannan in view of Kanevsky in further view of U.S. Patent No. 6,397,246 issued to Wolfe (“Wolfe”).

Claims 5-8 depend from claim 1 incorporating its limitations. As discussed above, claim 1 is patentable over the combination of Kannan and Kanevsky and Wolfe fails to remedy the deficiency of the combination. Specifically, Wolfe discloses matching various characteristics of a URL request – such as the URL, time of day, source IP address, etc. – to decide whether to display a pop-up ad. The text Examiner cites in column 5, lines 32-50, for example, shows that if the www.cnn.com URL is requested, a pop-up ad is displayed.

Even assuming *arguendo* that the method of Wolfe were characterized as analyzing the content of the locator of the first information page to determine whether the locator satisfies a locator based condition, the locator based condition of Wolfe is not disclosed as abstracting a plurality of locators of a plurality of locations having information that amplifies the information of the first information page as required by claims 5-8. A locator based condition that determines if a requested URL matches www.cnn.com, for example, does not *abstract a plurality of locators*. Rather, it is a locator based condition that requires the requested URL to match a *single locator*.

Further, as argued above, there could have been no suggestion to modify Kannan to achieve the method of claims 5-8. As such, Applicants submit that claims 5-8 are nonobvious and therefore patentable over Kannan either alone or in combination with Wolfe.

Additionally, claims 23, 24, 40, 41, 54, and 55 all depend from claims 19, 35, and 50, respectively, which contain in substance the same limitations as claim 1. Thus, for at least the reasons discussed above, Applicants submit that these claims are also patentable over the combination of Kannan, Kanevsky, and Wolfe.

On page 16 of the above-captioned Office Action, claims 13, 28, 45, and 59 are rejected under 35 U.S.C. §103(a) over Kannan in view of Kanevsky in further view US Patent No. 5,960,429 issued to Peercy et al (“Peercy”).

Claims 13, 28, 45 and 59 depend from claims 1, 19, 35, and 50, respectively, incorporating their limitations. As discussed above, claim 1 is patentable over the combination of Kannan and Kanevsky. Further, Peercy fails to remedy the deficiency of the combination. Peercy discloses a method by which a list of popular websites is compiled. It does not provide locator based conditions at all, much less locator based conditions “abstracting a plurality of locators of a plurality of locations having information that amplifies the information of the first information page” as required by claims 13, 19, 35, and 50. Thus, for at least these reasons and those discussed earlier, Applicants submit that these claims are nonobvious and therefore patentable over the combination of Kannan, Kanevsky, and Peercy.

On page 17 of the above-captioned Office Action, claims 14, 15, 29, 30, 46, 47, 60 and 61 stand rejected under 35 U.S.C. §103(a) over Kannan in view of Kanevsky in further view of US Patent No. 6,026,409 issued to Blumenthal (“Blumenthal”).

Claims 14, 15, 29, 30, 46, 47, 60 and 61 depend from claims 1, 19, 35, and 50, respectively, incorporating their limitations. As discussed above, claim 1 is patentable over the combination of Kannan and Kanevsky and Blumenthal fails to remedy the deficiency of the combination. Blumenthal discloses a method by a user search initiates two windows, one with locally-stored information that matches the user search, and the other with global information that matches the search. It does not provide locator based conditions at all, much less locator based conditions “abstracting a plurality of locators of a plurality of locations having information that amplifies the information of the first information page” as required by claim 14. Also, for at least the reasons discussed above, there could have been no suggestion to modify Kannan to achieve the method of claim 14. Thus, for at least this reason, Applicants submit that claim 14 is nonobvious and therefore patentable over Kannan in view of Blumenthal.

Further, claims 15, 29, 30, 46, 47, 60 and 61 depend from claims 1, 19, 35, and 50, respectively, which contain in substance the same limitations as claim 1. Thus, for at least these reasons Applicants submit that these claims are also patentable over Kannan in view of Blumenthal.

CONCLUSION

In view of the foregoing, Applicant submits that all pending claims are in condition for allowance. Accordingly, a Notice of Allowance is respectfully requested. If the Examiner has any questions concerning the present paper, the Examiner is kindly requested to contact the undersigned at (206) 407-1542. If any fees are due in connection with filing this paper, the Commissioner is authorized to charge the Deposit Account of Schwabe, Williamson and Wyatt, P.C., No. 50-0393.

Respectfully submitted,
SCHWABE, WILLIAMSON & WYATT, P.C.

Date: October 1, 2007

by: /Richard B. Leggett/
Richard B. Leggett
Reg. No.: 59,485

Schwabe, Williamson & Wyatt, P.C.
Pacwest Center, Suites 1600-1900
1211 SW Fifth Avenue
Portland, Oregon 97222
Telephone: 503-222-9981